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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/723,994	11/25/2003	Martin Newman	0EKM-108414	7981
30764	7590	05/26/2005	EXAMINER	
SHEPPARD, MULLIN, RICHTER & HAMPTON LLP 333 SOUTH HOPE STREET 48TH FLOOR LOS ANGELES, CA 90071-1448			CHAMBERS, MICHAEL S	
			ART UNIT	PAPER NUMBER
			3711	

DATE MAILED: 05/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	Application No. 10/723,994	Applicant(s) NEWMAN ET AL.	
	Examiner Mike Chambers	Art Unit 3711	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 26 April 2005.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-17, 20-25, 27 and 28 is/are pending in the application.
- 4a) Of the above claim(s) 7-17 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6, 20-25, 27 and 28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
     Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
     Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftperson's Patent Drawing Review (PTO-948)                                    | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Election/Restrictions***

Applicant's election without traverse of claims 1-7,20-25,27 and 28 is acknowledged. Claims 8-19, 19 and 26 are withdrawn from further consideration, as directed to claims non-elected without traverse.

### ***Information Disclosure Statement***

The information disclosure statement filed 7/30/04 fails to comply with 37 CFR 1.98(a)(2), which requires a legible copy of each cited foreign patent document; each non-patent literature publication or that portion which caused it to be listed; and all other information or that portion which caused it to be listed. It has been placed in the application file, but the information referred to therein has not been considered. Note: The foreign documents cited in the IDS were not submitted.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-7,25, 27 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker et al (6007434). Baker discloses the elements of claim 1, however it fails to clearly disclose a spaced apart distance of at least 0.1mm and a volume of less than 0.0007 mm<sup>3</sup>. The applicant has discloses these limitations as a

preferred embodiment but the specification does not disclose any unexpected or surprising results from using these limitations. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the any one of several equivalent geometric designs based on cost and design considerations.

As to claim 2 : Baker discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.02mm. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 3 and 4 : Baker discloses geometric shapes. The area disclosed in fig 2 would be less than 15%. The specification provides no unexpected results in having a total volume of less than 15%. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 5 : Baker discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.0003mm<sup>3</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape and volume based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 6 : Baker discloses geometric shapes having the same shape and size (fig 2).

As to claim 7 : Baker discloses a plurality of grooves (fig 1- item 16a).

As to claim 25 : Baker discloses a plurality of first and second shapes (fig 2).

As to claim 27 : Baker discloses geometric shapes. The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 28 : Baker discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.05 mm<sup>2</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that it is well known in the art to weld to attach the members. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations.

As to claim 21 : Baker discloses a club with the front wall and sole integrally formed with each other (fig 1).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baker as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent lofts based on cost and design considerations and to increase the player satisfaction with the device.

Also,

Claims 1-4,6,7,25 and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon (6110057). McKinnon discloses the elements of claim 1, however it fails to clearly disclose a spaced apart distance of at least 0.1mm and a volume of less than 0.0007 mm<sup>3</sup>. The applicant has discloses these limitations as a preferred embodiment but the specification does not disclose any unexpected or surprising results from using these limitations therefore they are obvious design choices. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the any one of several equivalent geometric designs based on cost and design considerations.

As to claim 2 : McKinnon discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.02mm. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claims 3 and 4 : McKinnon discloses geometric shapes. The area disclosed in fig 3 would be less than 15%. The specification provides no unexpected results in having a total volume of less than 15%. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 6 : McKinnon discloses geometric shapes having the same shape and size (fig 3).

As to claim 7 : McKinnon discloses a plurality of grooves (fig 5).

As to claim 25 : McKinnon discloses a plurality of first and second shapes (fig 4).

As to claim 28 : McKinnon discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.05 mm<sup>2</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that it is well known in the art to weld to attach the members. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations.

As to claim 21 : McKinnon discloses a club with the front wall and sole integrally formed with each other (fig 1).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over McKinnon as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent

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lofts based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 27 : McKinnon discloses geometric shapes. The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

Also,

Claims 1-4,6,7, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miesch et al (4964641). Miesch discloses the elements of claim 1, however it fails to clearly disclose a spaced apart distance of at least 0.1mm and a volume of less than 0.0007 mm<sup>3</sup>. The applicant has discloses these limitations as a preferred embodiment but the specification does not disclose any unexpected or surprising results from using these limitations therefore they are obvious design choices. It would have been obvious to one of ordinary skill in the art at the time of the invention to have employed the any one of several equivalent geometric designs based on cost and design considerations.

As to claim 2 : Miesch discloses geometric shapes. The specification provides no unexpected results in having a total volume of less than 0.02mm. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.



As to claims 3 and 4 : Miesch discloses geometric shapes. The area disclosed in fig 4 would be less than 15%. The specification provides no unexpected results in having a total volume of less than 15%. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 6 : Miesch discloses geometric shapes having the same shape and size (fig 1).

As to claim 7 : Miesch discloses a plurality of grooves (fig 1).

As to claim 28 : Miesch discloses geometric shapes. The specification provides no unexpected results in having a forward striking face that is less than 0.05 mm<sup>2</sup>. It would have been obvious to one of ordinary skill in the art to have selected an appropriate geometric shape based on cost and design considerations and to increase the player satisfaction with the device.

Claims 20-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miesch as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that it is well known in the art to weld to attach the members. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent attachment means based on cost and design considerations.

As to claim 21 : Miesch discloses a club with the front wall and sole integrally formed with each other (fig 1).

Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miesch as applied to claim 1 above, and further in view of Official Notice. Official Notice is taken that the loft angles cited are well known in the art. It would have been obvious to one of ordinary skill in the art to have selected any one of several equivalent lofts based on cost and design considerations and to increase the player satisfaction with the device.

As to claim 27 : Miesch discloses geometric shapes. The specification provides no unexpected results in having more than one orientation. It would have been obvious to one of ordinary skill in the art to have selected an appropriate design and orientation based on cost and design considerations and to increase the player satisfaction with the device.

### ***Conclusion***

Note: The specification fails to clearly disclose what the applicant believes the novelty of the invention is. Although the specification has provided some design considerations, the examiner fails to see how the instant invention avoids obvious design choices based on cost and design considerations.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mike Chambers whose telephone number is 571-272-4407. The examiner can normally be reached on Mon-Fri 8:30-5:00.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Vidovich can be reached on 571-272-4415. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

4964641\*6007434\*6110057

Michael Chambers  
Examiner  
Art Unit 3711

May 23, 2005

  
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